

Message Text

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P 141821Z NOV 74
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TO AMEMBASSY WARSAW PRIORITY

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E.O. 11652:N/A

TAGS: EIND, BDIS, PL

SUBJECT: ALLEGED POLISH PATENT INFRINGEMENT

1. A US PATENT ATTORNEY (MARIO A. MONACO) FOR MERCK & CO., INC. WILL TRAVEL TO WARSAW WITH REGARD TO PENDING PATENT LITIGATION BETWEEN MERCK AND A POLISH COMPANY, POLFA, CONCERNING ALLEGED INFRINGEMENT OF MERCK AND SUMITOMO CHEMICAL COMPANY'S JOINT PATENT RIGHTS AS TO THE PHARMACEUTICAL PRODUCT, "INDOMETHACIN". (THE POLISH PATENT IS IN THE NAME OF SUMITOMO - NO. 64,883 - TO WHICH MERCK HAS JOINT PATENT RIGHTS.)

2. MONACO'S ITINERARY IS AS FOLLOWS: DEPARTS FRANKFURT ON NOVEMBER 17 (SUNDAY) ON LUFTHANSA NO. 346 AT 10:35 A.M. ARRIVING WARSAW AT 12:25 P.M.; DEPARTS WARSAW NOVEMBER 20 (WEDNESDAY) ON SWISSAIR NO. 491 AT 9:00 A.M. FOR ZURICH. WHILE IN WARSAW, MONACO WILL BE AT THE HOTEL FORUM.

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3. TRAVELING SEPARATELY TO WARSAW WILL BE DR. ALAN W. DOUGLAS, ANALYTICAL CHEMIST WITH MERCK, WHO WILL BE ONE OF MERCK'S TECHNICAL EXPERTS IN THIS PROCEEDING. DOUGLAS WILL ARRIVE IN WARSAW SOMETIME BETWEEN NOVEMBER 15 AND 17.

4. PURPOSE OF MONACO'S TRIP TO WARSAW IS TO BRIEF MERCK'S POLISH ATTORNEY, A MR. HANKE, ABOUT THE HEARINGS ON NOVEMBER 19 BEFORE THE POLISH PATENT OFFICE IN A NULLITY ACTION AGAINST POLFA'S PATENT NO. 62,464

AND IN A COUNTER-ACTION BROUGHT BY POLFA AGAINST MERCK TO HAVE POLFA'S PROCESS DECLARED DIFFERENT FROM THAT COVERED BY MERCK'S PATENT RIGHTS. MONACO ALSO PLANS TO BRIEF MERCK'S OTHER POLISH ATTORNEY, A DR. KLEIN, WITH REGARD TO MERCK'S INFRINGEMENT ACTION AGAINST POLFA ON THE SAME SUBJECT MATTER.

5. FYI MERCK HAS CONTACTED THE DEPARTMENT BECAUSE OF CERTAIN UNUSUAL ACTIONS APPARENTLY TAKEN BY POLISH GOVERNMENTAL AUTHORITIES REGARDING THIS MATTER. MERCK IS CONCERNED THAT THE POLISH TRIBUNAL WILL NOT GIVE MERCK A FULL OPPORTUNITY TO PRESENT ANY FURTHER EVIDENCE NOR GRANT MERCK ANY EXTENSION OF TIME TO DO SO. MERCK FINDS ITSELF IN THIS PREDICAMENT BECAUSE THE TRIBUNAL SET THE HEARING DATES SOONER THAN EXPECTED AND GAVE MERCK ONLY TWO WEEKS NOTICE BEFORE THE NOVEMBER 20 HEARING DATE. FURTHER, DURING THE PAST FEW MONTHS MERCK BELIEVES THAT POLISH AUTHORITIES MAY HAVE OPERATED BEHIND THE SCENES TO PREVENT MERCK'S POLISH ATTORNEYS MEETING IN ZURICH FOR CONSULTATIONS WITH A SWISS ATTORNEY INVOLVED IN THE PROCEEDING. FOR EXAMPLE, MONACO MADE AN APPOINTMENT WITH DR. KLEIN IN ZURICH ON OCTOBER 21, 1974 AND WENT TO ZURICH FROM THE U.S. FOR THE SPECIFIC PURPOSE OF DISCUSSING THE CASE WITH KLEIN WHO WOULD, IN TURN, FURTHER BRIEF HANKE, MERCK'S OTHER POLISH ATTORNEY. AT THE LAST MOMENT MONACO RECEIVED A TELEX IN ZURICH FROM KLEIN INDICATING HE COULD NOT KEEP THE APPOINTMENT. MERCK THEREFORE FINDS ITSELF ON THE ONE HAND HAVING DIFFICULTY MEETING WITH THEIR POLISH ATTORNEYS WHILE AT THE SAME

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TIME HAVING THE HEARINGS ON THEIR ACTIONS SET AT VERY EARLY DATES. END FYI.

6. U.S. AND POLAND ARE BOTH PARTIES TO THE PARIS INDUSTRIAL PROPERTY CONVENTION. AMONG OTHER THINGS, THIS CONVENTION PROVIDES FOR "NATIONAL TREATMENT" WITH REGARD TO THE PROTECTION OF PATENTS, TRADEMARKS AND OTHER FORMS OF INDUSTRIAL PROPERTY.

7. EFFECTIVE PATENT PROTECTION IS AN IMPORTANT ELEMENT IN TRADE BETWEEN THE U.S. AND POLAND. U.S. NATIONALS FILED MORE PATENT APPLICATIONS IN POLAND IN 1972 THAN DID NATIONALS OF ANY OTHER COUNTRY EXCEPT THE FEDERAL REPUBLIC OF GERMANY. MERCK IS ONE OF THE LARGEST U.S.

PHARMACEUTICAL FIRMS AND HAS A WORLD-WIDE PATENT FILING PROGRAM. IT HAS NUMEROUS POLISH PATENTS INCLUDING AT LEAST 4 PATENTS RELATING TO "INDOMETHACIN". IF THERE IS ANY INDICATION OF UNFAIR OR DISCRIMINATORY PRACTICES ON THE PART OF THE POLISH TRIBUNAL IN THIS MATTER, THIS COULD BE A NEGATIVE FACTOR IN U.S.-POLISH TRADE RELATIONS.

8. MONACO PLANS TO VISIT THE EMBASSY ON NOVEMBER 18 TO DISCUSS THIS MATTER AND PROVIDE THE EMBASSY WITH ADDITIONAL BACKGROUND INFORMATION.

9. ACTION: THE EMBASSY IS REQUESTED TO PROVIDE APPROPRIATE ASSISTANCE TO MONACO AND DOUGLAS. IF THE EMBASSY PERCEIVES AN OPPORTUNITY TO EXPRESS TO APPROPRIATE POLISH AUTHORITIES AN INTEREST IN THIS PROCEEDING INVOLVING AN IMPORTANT AMERICAN COMPANY, THE EMBASSY IS AUTHORIZED TO DO SO. KISSINGER

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